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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,228	03/12/2002	Joc Z. Tsien		5571

33729 7590 03/07/2006

LAW OFFICES OF ALBERT WAI-KIT CHAN, LLC  
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EXAMINER

STANDLEY, STEVEN H

ART UNIT PAPER NUMBER

1649

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



## **DETAILED ACTION**

### ***Response to Amendment***

The amendment filed 12/09/05 has been made of record. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior office action.

### **Objections/Rejections: Withdrawn**

#### ***Claim Rejections - 35 USC § 112***

The rejection of claims 29-34 under 35 USC 112, 2<sup>nd</sup> paragraph, for reciting a relative term is withdrawn due to Applicant's amendment.

### **Objections/Rejections: Maintained/New Grounds**

#### ***Claim Objections***

Objection to claims 29-34 is maintained for the reasons made of record in the office action dated 6/6/05. Applicant's arguments have been fully considered and not found to be persuasive. Applicant argues that the examiner agreed to examine claim 28. The examiner considered the claim only to the extent that it was readable upon the elected invention Group IV (claims 29-34).

This application contains a claim (28) drawn to an invention nonelected with traverse in Paper No. 3/09/05. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Claim Rejections - 35 USC § 112***

Rejection of claim 28-34 under 35 USC § 112, 1<sup>st</sup> paragraph, enablement is maintained for the reasons made of record in the office action dated 6/06/05. Applicant's arguments have been fully considered and not found to be persuasive. Applicant argues only that the invention is fully enabled, stating that "the test compound enhanced learning and memory." It is noted by the examiner that Applicant argues that the nucleic acid overexpressing the NR2B subunit of the NMDA receptor in a transgenic animal is a "test compound." However, the claims use a cell expressing said nucleic acid as a "control" for comparison to evaluate the effects of another "test compound" on a cell that does not contain said nucleic acid. As argued in the office action of 6/06/05, the art discloses that a "test compound" affecting NMDA receptor expression, activity, or function does not enhance learning and memory (page 6-7 of office action), and that a test compound that *does* enhance learning and memory does not modify NMDA receptor expression, activity or function (see page 8 of office action). Therefore, given the complex nature of the invention, the contradictory prior art, the high level of unpredictability of the art, and the lack of guidance or examples as to how to make or use the invention as currently claimed, one skilled in the art would require undue experimentation to make and use the invention.

**Conclusion**

No claim is allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven H. Standley whose telephone number is (571) 272-3432. The examiner can normally be reached on 8:00-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Janet Andre can be reached on (571) 272-0867. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Steven Standley, Ph.D.

2/23/06  


  
ROBERT C. HAYES, PH.D.  
PRIMARY EXAMINER